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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/670,247

09/26/2003

Kohji Kanbara

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03/06/2009

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
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EXAMINER

CHAMPAGNE, DONALD

ART UNIT

PAPER NUMBER

3688

NOTIFICATION DATE

DELIVERY MODE

03/06/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/670,247	Applicant(s) KANBARA, KOHJI	
	Examiner Donald L. Champagne	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-27 and 34-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-27 and 34-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 16-27 and 34-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Kolls (US006615183B1).
3. Kolls teaches (independent claims 16, 22, 34, 35 and 36, and dependent claims 17 and 23) an image forming and information processing apparatus, and a banner advertisement method, the image forming apparatus comprising:

a communications mechanism (*a universal server*, col. 23 lines 8-9 and col. 13 lines 19-21, using *modem 544*, col. 25 lines 22-29) configured to communicate with a banner advertiser terminal (also the *universal server*, col. 23 lines 8-9) via a network (*network 600*, col. 23 lines 8-9 and col. 13 lines 24-25);

a banner advertisement storage unit (*a database*, col. 33 lines 44-52) configured to store at least two banner advertisements from the banner advertiser terminal (*universal server*);

a displaying mechanism (*a system 500*, col. 23 lines 9-12, with *display means 580* or **582** (col. 15 lines 1-3 and 21-23 and col. 7 lines 6-60 including Figs. 3B-3D, and col. 4 lines 13-14) configured to display, within the image forming apparatus, a banner advertisement (col. 33 lines 63-65), stored in the banner advertisement storage unit (*a database*, col. 33 lines 44-52), offering at least one of a product and services (col. 6 lines 11-18); and

a response sending mechanism (*LAN network connection means 556*, col. 15 lines 3-19) configured to send to the banner advertiser terminal, through the communications

mechanism, at least one of an order and an inquiry for the at least one of the product and the services offered by the banner advertisement displayed on the displaying mechanism.

For claims 17, 23, 34, 35 and 36, Kolls also teaches displaying when the image forming apparatus is in a “non-operative” state (col. 34 lines 39-41).

4. Note on interpretation of claim terms - Unless a term is given a “clear definition” in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so “with reasonable clarity, deliberateness, and precision” (MPEP § 2111.01.III). A “clear definition” must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as “by xxx we mean”; “xxx is defined as”; or “xxx includes, ... but does not include ...”. An example does not constitute a “clear definition” beyond the scope of the example.
5. The instant application contains no such clear definition for any of its claim terms, two of which are unclear. Hence, the examiner is required to give these terms their broadest reasonable interpretation. First, “an image forming apparatus” is interpreted as any apparatus which “integrates multiple functions” including at least one of those stated in para. [0004] of the published application (US 20040117258A1). That is taught by Kolls at col. 6 lines 6-60, Fig. 3B-3D and col. 4 lines 13-14 as the integrated system **500**. Second, the examiner interprets “ad “registration” (claims 20 and 26) to mean “enrollment”, establishing the ad in the server for delivery. This is inherent since Kolls teaches delivery of the ads from the server (*universal server*, col. 13 lines 19-25) to the displaying mechanism, so they must have been “registered” with the server.
6. Kolls also teaches claims 18 and 24 (col. 44 lines 45, where “email” is interpreted as any electronic text communication), claim 19 and 25 (col. 17 lines 50-55, where *transaction receipt* reads on an order return message) and claims 21 and 27 (col. 12 line 49).

Response to Arguments

7. Applicant's arguments filed with an amendment on 8 January 2009 have been fully considered but they are not persuasive. Applicant argues (p. 6, center), "not only does Kolls fail to teach or suggest a banner advertisement storage unit as defined by Claim 16, but the principle of operation of Kolls precludes storage". Applicant is wrong on both counts: Kolls teaches storage (col. 33 lines 44-52) and it is impossible to display an electronic image without first storing it.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
9. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached Monday, Wednesday morning, and after Noon on Thursday and Friday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
11. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722.
12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information

for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

13. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
14. Applicant may have after final arguments considered and amendments entered by filing an RCE.
15. Applicant is advised that, unless a proposed amendment is filed after final and the examiner returns an advisory action with block 3(a) checked (signifying that further search or consideration is required), an amendment filed with an RCE **COULD BE MADE FINAL IN THE FIRST ACTION** in accordance with MPEP § 706.07(b).
16. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

1 March 2009

/Donald L. Champagne/
Primary Examiner, Art Unit 3688